

REMARKS

Claims 1-51 are pending in the present application. Claims 1, 4, 10, 12, 13, 16, 17, 23, 25, 27, 30, 37, 39, 41, 44 and 49 are independent.

Entry of the Declaration dated December 8, 2003, from the named inventor Dorée D. Seligmann pursuant to 37 C.F.R. § 1.131 ("Seligmann Declaration") was denied as "not directed SOLELY to issues which were newly raised by the Examiner in the final rejection" and as "raising new issues that would require more than a cursory review."

Action at 1 and 2.

The Applicant respectfully notes that a previous declaration (the "Yacura Declaration") filed June 3, 2003, in response to the non-final rejection presented testimony and supporting evidence that:

Prior to October 30, 1998, Doree Seligmann had disclosed the invention to the law firm of Birch, Stewart, Kolasch & Birch for preparation of a patent application, where the present application was assigned the attorney docket number of 2925-110P.

Prior to October 30, 1998, an associate, Esther Chin, under my supervision at Birch, Stewart, Kolasch & Birch, had completed a draft of the present application, which was approved by Doree Seligmann and submitted to a representative of Lucent Technologies' legal department, Eugene Rosenthal, via facsimile, for approval. (A copy of the cover page and transmission report of this facsimile (with dates redacted) is attached as Exhibit A).

Yacura Declaration, ¶¶ 3 and 4.

Although the Yacura Declaration was found by the Examiner "to be ineffective" in antedating the Wang reference without a copy of the referenced draft, the Applicant

respectfully submits that the *issue* regarding Wang's applicability as prior art against the claimed invention was clearly raised in response to a non-Final Office Action.

The Applicant respectfully contends, therefore, that the Seligmann Declaration raised no "new issue," but merely addressed the deficiencies noted by the Examiner in the August 12, 2003, Final Office Action with regard to the Yacura Declaration. The Applicant respectfully submits that the Seligmann Declaration is wholly consistent with the facts and evidence as stated in the Yacura Declaration regarding the disclosure of the invention and the creation, transmission and approval of the draft application, a copy of which was attached as Exhibit B. The Applicant thus contends that the Seligmann Declaration addresses only an issue, the alleged deficiency of the supporting evidence provided with the Yacura Declaration, that was "newly raised" in the final rejection.

The Applicant further contends that, given the substantial correspondence between the draft application provided with the Seligmann Declaration and the present application as filed, only a "cursory review" of these materials would have been necessary to confirm the factual basis for the substantially identical statements in the Yacura and Seligmann Declarations regarding activity antedating the Wang reference.

CONCLUSION


In view of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider the refusal to enter and consider the Seligmann Declaration, withdraw of all rejections predicated on the Wang reference and allow pending claims 1-51.

In the event that the Examiner is not persuaded by Applicant's arguments, or any other outstanding matters remained in the present application, the Examiner is invited to contact the undersigned at (703) 668-8000 to discuss this application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; including, in particular, extension of time fees.

Respectfully submitted,

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